

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

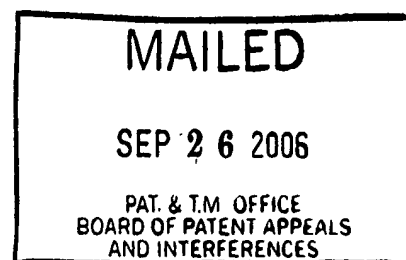
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIRK S. GIBONEY and JONATHAN SIMON

Appeal No. 2006-1719
Application No. 10/007,494

ON BRIEF



Before THOMAS, JERRY SMITH, and HOMERE, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-15, 19, 20, 22, and 25-31. Pending claims 16-18, 21, 23, and 24 had been indicated by the examiner to contain allowable subject matter. After the filing of the brief on appeal, the examiner has allowed claims 13-24 and has indicated that claims 4, 6, 8, 11,

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references

relied on as evidence of obviousness. Id. 277 F.3d at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000)). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative

persuasiveness of the arguments. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision.

Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

With respect to the claims remaining on appeal, appellants have indicated that the claims will stand or fall together in the following three groups: Group I has claims 1-3, 5, 7, 10, and 12, Group II has claim 9, and Group III has claims 25-27 and 29-31 [brief, page 5]. Consistent with this indication appellants have made no separate arguments with respect to any of the claims within each group. Accordingly, all the claims within each group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against claims 1, 9, and 25 as representative of all the claims on appeal.

With respect to representative claim 1, the examiner finds that O'Connor teaches the claimed invention except that O'Connor does not teach that the lid portion is adapted to have at least a portion of the optical communications device 18 therebetween. The examiner notes that the admitted prior art shows the communications device connected between the lid portion and the base portion. The examiner finds that it would have been obvious to the artisan to modify O'Connor by placing the optical device at

least partially between the lid and base portion of the device as taught by the admitted prior art. The examiner also notes that O'Connor fails to teach that the alignment member 28 is formed on the lid portion. The examiner finds that it would have been an obvious modification to form the alignment members on a part of the device as opposed to through that part of the device because the functionality is the same, citing *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) [answer, pages 3-5].

Appellants argue that O'Connor contains no motivation or suggestion that alignment members can or should be formed on a lid portion of an enclosure. They note that the only suggestion for this alignment comes from their disclosure. Appellants also argue that the decision in *Larson* is not pertinent to the question of obviousness in this case because of the difference in the facts [brief, pages 6-9].

The examiner responds that it would have been obvious to the artisan to form the alignment members on the lid instead of through the lid because it functions the same, and reiterates that securing alignment members to either the base or the lid is not a patentable distinction based on the holding in *Larson* [answer, pages 6-7].

Appellants respond that the functionality of the prior art and the claimed invention is not the same because the alignment members of the claimed invention provide significant advantages over the alignment members in O'Connor [reply brief, pages 3-5].

We will not sustain the examiner's rejection of representative claim 1 or of the other claims of Group I for essentially the reasons argued by appellants in the briefs. The examiner's reliance on a per se rule from *Larson* is misplaced. The examiner has applied this per se rule without considering the specific facts of this case. The examiner asserts obviousness based on common functionality even though appellants have asserted a functional advantage over the prior art. The examiner has not even addressed appellants' assertion that the particular claimed location of the alignment members achieves an advantage in batch processing that the admitted prior art or O'Connor does not achieve. We are simply of the view that the examiner has failed to properly address the obviousness of the differences between the claimed invention and the teachings of the applied prior art.

With respect to separately argued claim 9, since claim 9 depends from claim 1, we also do not sustain the examiner's rejection of claim 9 for the reasons discussed above with respect to claim 1.

With respect to representative claim 25, the examiner finds that O'Connor teaches a structure that is divisible into two or more components. The examiner also points to the discussion above with respect to the obvious difference between "formed on" and "formed through" [answer, pages 5-6].

Appellants argue that O'Connor nowhere discloses or suggests a structure that is divisible as claimed and adapted to join with a connector of an optical cable as claimed. Appellants also argue that O'Connor fails to disclose at least two alignment members on the second substrate as claimed [brief, pages 12-13].

The examiner responds by relying on positions considered above. The examiner also reiterates that the device components in O'Connor are divisible [answer, pages 7-8]. Appellants respond that even if the components in O'Connor are divisible, O'Connor does not disclose two or more structures that are adapted to join with a connector of an optical cable as claimed. Appellants also respond that O'Connor fails to teach the two substrates having electrical devices positioned therebetween as claimed. Finally, appellants note that O'Connor nowhere discusses manufacturing enclosures in a batch process [reply brief, pages 5-6].

We will not sustain the examiner's rejection of representative claim 25 or of the other claims in Group III for the reasons argued by appellants in the briefs. In addition to the comments made above with respect to claim 1, we also find that the examiner has failed to demonstrate how the "divisible" devices of O'Connor are each adapted to join with a connector of an optical cable as claimed.

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Avago Technologies, LTD.
P.O. Box 1920
Denver, CO 80201-1920